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| PPLICATION NO.           | F    | ILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.     | CONFIRMATION NO. |
|--------------------------|------|------------|----------------------|-------------------------|------------------|
| 10/033,259 12/28/2001    |      | 12/28/2001 | Steven S. Bachand    | 2843                    | 8123             |
| 23693                    | 7590 | 09/27/2004 |                      | EXAMINER                |                  |
| Varian Inc<br>Legal Depa | •    |            | NGUYEN, BAO THUY L   |                         |                  |
| 3120 Hansen Way D-102    |      |            |                      | ART UNIT                | PAPER NUMBER     |
| Palo Alto, CA 94304      |      |            |                      | 1641                    |                  |
|                          |      |            |                      | DATE MAILED: 09/27/2004 |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|  |  | Application No.  | Applicant(s)                                      |  |  |  |  |  |
|--|--|--|---|--|--|--|--|--|
|  | Office Action Summer.  | 10/033,259   | BACHAND, STEVEN S.                                |  |  |  |  |  |
|  | Office Action Summary  | Examiner   | Art Unit  |  |  |  |  |  |
|  |  | Bao-Thuy L. Nguyen   | 1641  |  |  |  |  |  |
| The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply   |  |  |   |  |  |  |  |  |
| A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). |  |  |   |  |  |  |  |  |
| Status   |  |  |   |  |  |  |  |  |
| 1)⊠ R  | esponsive to communication(s) filed on <u>28 De</u>  | ecember 2001.  |   |  |  |  |  |  |
|  | This action is <b>FINAL</b> . 2b) This action is non-final.  |  |   |  |  |  |  |  |
| 3)∐ Si   | 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is   |  |   |  |  |  |  |  |
|  | osed in accordance with the practice under Ex  |  |   |  |  |  |  |  |
| Disposition  |  |  |   |  |  |  |  |  |
| 4a<br>5)□ Cl<br>6)□ Cl   | aim(s) 1-25 is/are pending in the application.  Of the above claim(s) is/are withdraw aim(s) is/are allowed.  aim(s) is/are rejected.  aim(s) is/are objected to.  | n from consideration.  |   |  |  |  |  |  |
|  | aim(s) <u>1-25</u> are subject to restriction and/or el  | lection requirement.   |   |  |  |  |  |  |
| Application  | Papers   |  | r   |  |  |  |  |  |
| 10)∐ Th∈<br>Ap<br>Re   | e specification is objected to by the Examiner. e drawing(s) filed on is/are: a) acceplicant may not request that any objection to the displacement drawing sheet(s) including the correction on the order of the displacement drawing sheet(s) including the correction is objected to by the Examiner. | pted or b) objected to by the Examing(s) be held in abeyance. See on is required if the drawing(s) is obje | 37 CFR 1.85(a).<br>ected to. See 37 CFR 1.121(d). |  |  |  |  |  |
| Priority und   | er 35 U.S.C. § 119   |  |   |  |  |  |  |  |
| <ul> <li>12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</li> <li>a) All b) Some * c) None of:</li> <li>1. Certified copies of the priority documents have been received.</li> <li>2. Certified copies of the priority documents have been received in Application No.</li> <li>3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> </ul>   |  |  |   |  |  |  |  |  |
| * See the attached detailed Office action for a list of the certified copies not received.   |  |  |   |  |  |  |  |  |
| 2)  Notice of<br>3)  Information   | References Cited (PTO-892)<br>Draftsperson's Patent Drawing Review (PTO-948)<br>on Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>(s)/Mail Date  | 4) Interview Summary (P Paper No(s)/Mail Date 5) Notice of Informal Pat 6) Other:                          | PTO-413)<br>e<br>ent Application (PTO-152)        |  |  |  |  |  |

## Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 16-26 have been renumbered 12-21, respectively.

## Election/Restrictions

- **2.** Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-11 and 12-18, drawn to a binding assay device and method of making, classified in class 436, subclass 514, for example.
  - II. Claims 19-21, drawn to a binding assay device and method of making, classified in class 435, subclass 287.1, for example.
- 1. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and they have different modes of operation. The device of Group I requires reagents to be present between a non-absorbent medium and a membrane, whereas the device of Group II requires reagents to be present on an adhesive surface between non non-absorbent medium and a membrane. Furthermore the method of making each of the device operates differently.

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- 2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because the search required for Group I is not coextensive with the search required for Group II, and since searching Groups I and II together would be burdensome, restriction for examination purposes as indicated is proper.
- **3.** Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
- **4.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bao-Thuy L. Nguyen whose telephone number is (571) 272-0824. The examiner can normally be reached on Tuesday and Thursday from 8:00 a.m. -3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on (571) 272-0823. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BAO-THUY L. NGUYEN PRIMARY EXAMINER 9/23/04